

REMARKS

File History

Applicant thanks the Examiner for the advance warning telephone call of December 19, 2008, in which several options were discussed as a means for avoiding the §101 rejection of the present Office action (12/24/2008). No agreement was reached and the present written rejection ensued.

In the outstanding non-final Office action of December 24, 2008, the following allowances, rejections, objections, requirements and other actions appear to have been made:

- **Claims 42-56** are allowed.
- **Claims 34-37, 39-41** are rejected under 35 USC §101 as being "directed" to nonstatutory subject matter.
- **Claim 38** is objected to, but otherwise allowed.

Summary of Current Response

Claim 34 is amended.

Applicants' Overview of Outstanding Office Action

First off, it is to be noted that none of the statutes in 35 USC recite the concept of a claim pointing to, or being "directed" to something. Claims embrace or cover subject matter by setting forth metes and bounds (limitations). A deed to real estate would never be said to be "directed" to something. It instead sets forth the metes and bounds of the real estate to which the owner claims rights of exclusive enjoyment. While courts may have the luxury of using senseless words like "directed", an administrative agency such as the USPTO should be more constrained to stick with objective law rather than delving arbitrarily and capriciously into poetic language.

35 USC §101 says "any new and useful process". The word "any" is broad and expansive. If no prior art is available to negate the "new" requirement, then the only objective issue under §101 is whether a claimed method is part of the "useful arts" pursuant to the U.S. Constitution. Claim 34 (as amended) embraces a "A machine-implemented method that defines an image displayed by a display device". It has not been shown by the USPTO that displaying an image on a display device (a particular machine or manufacture) is not part of the useful arts. In fact, notice should be taken that the USPTO regularly and routinely issues patents for methods of displaying images by means of particular apparatus. It would be arbitrary and capricious agency action to make an exception of this particular case.

It is noted that the written Office action does not proclaim any unusual reading of the claims, such as ignoring preambles. Therefore Applicant is fully in his rights to be expecting the USPTO to be giving full weight to the whole of the claim in accordance with normal and modern rules of claim construction.

[W]here a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation. *See Bell Communications*, 55 F.3d at 620; *Kropa v. Robie*, 38 C.C.P.A. 858, 187 F.2d 150, 152, 88 USPQ 478, 481 (1951).

The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d [1251] at 1257 [(Fed. Cir. 1989)]. The inquiry involves examination of the entire patent record to determine what invention the patentee intended to define and protect.

Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). [Emphasis added.]

This response is part of the patent record. Applicants hereby declare that the preamble of Claim 34 is not there "only" to state a purpose. Paragraph (c) in the claim body makes antecedent reference to "said image displayed by the display device". The preamble is thus necessary to breathe life and meaning into the body of the claim. See again *Bell Communications*, cited above.

Although not expressly stated in the 12/24/2008 Office action, it appears to be based on *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. October 2008).

The Bilski court explained that a purpose of §101 rejections is "prevention of pre-emption of **fundamental principles**" [*emphasis added*]. In that same breath (next sentence in opinion) the court stated: " So long as the claimed process is limited to a practical application of a fundamental principle to transform specific data, and the claim is limited to a visual depiction that represents specific physical objects or substances, there is no danger that the scope of the claim would wholly pre-empt all uses of the principle." [*emphasis added*]. The court also observed: "We further note for clarity that the electronic transformation of the data itself into a visual depiction in Abele was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented." [*emphasis added*].

Applicant reads these proclamations by the Bilski court as first requiring the USPTO to articulate what "fundamental principle" the agency is alleging to be the one that is being wholly pre-empted by the process claim under scrutiny. As well known, the term "*fundamental principle*" is defined in Bilski footnote 5 to mean: "As used in this opinion, "fundamental principles" means "laws of nature, natural phenomena, and abstract ideas." In other words, Applicant reads Bilski as implicitly requiring the USPTO to articulate what law(s) of nature, natural phenomena, and/or abstract idea(s) are alleged to be wholly pre-empted by the process claim under scrutiny. If such is not done, the determination to raise a §101 rejection may be seen to be one that is arbitrary, capricious and not in accordance with law. It is respectfully submitted that such articulation of a "*fundamental principle*" has not been provided in the present case and thus a reason for rejection has not been provided pursuant to 35 USC §132.

Applicant also reads the proclamations in Bilski court as excusing from more detailed analysis, process claims that involve electronic transformation of data into a visual depiction.

It is respectfully submitted that Claim 34, as amended above, at least falls under the visual depiction exception because it recites: "(c) using the identified conversion matrix to convert ... into a corresponding target color data signal that defines said image displayed by the display device."

Moreover, it is respectfully submitted that Claim 34, as amended above, ties the claimed process to a particular machine, namely, "a display device having M color sources

each respectively outputting a respective one of M unique primary colors, where ..." (recited in the preamble). The process of Claim 34 also transforms the recited display device into a different state or thing, namely one that has its displayed image defined by the machine implemented process of Claim 34.

In view of the above, it is respectfully submitted that there is no basis for continuing to reject Claim 34 and its dependencies under 35 USC §101. Withdrawal of the rejections is respectfully solicited.

CONCLUSION

It is believed that all outstanding grounds of rejection have been overcome or traversed in light of the foregoing. Applicant respectfully requests entry of the amendments and reexamination with favorable outcome. Should any other action be contemplated by the Examiner, it is respectfully requested that he/she contact the undersigned at (408) 392-9250 to discuss the application.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 08-1394 for any matter in connection with this request, including any fee for extension of time (requested here) and/or other fee which may be required.

CERTIFICATE OF EFS-WEB TRANSMISSION
Certificate of Transmission: I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office (USPTO) via the USPTO's EFS-Web electronic system on

April 23, 2009

Typed or printed name of person signing this certificate:
Robyne Orlando

Signature: Robyne Orlando

Respectfully submitted,



Edward C. Kwok
Attorney for Applicant
Reg. No. 33,938

Haynes and Boone, LLP
2033 Gateway Place, Suite 400
San Jose, California 95110
Phone: 408.392.9250
Fax: (214) 200-0854
E-mail: ipdocketing@haynesboone.com

Haynes and Boone LLP
2033 Gateway Place, Suite 400
San Jose, CA 95110
Telephone: (408) 392-9250
Facsimile: (408) 392-9262